

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:)	Mail Stop Appeal Brief – Patents
)	
Jan SWERUP et al.)	Group Art Unit: 2614
)	
Application No.: 10/576,474)	Examiner: A. Jamal
)	
Filed: April 20, 2006)	
)	
For: MESSAGE HANDLING IN)	
PORTABLE ELECTRONIC)	
DEVICES)	

U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief – Patents
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401 Dulany Street
Alexandria, VA 22314

APPEAL BRIEF

Sir:

This Appeal Brief is submitted in response to the final Office Action, dated September 24, 2009, and in support of the Notice of Appeal filed January 25, 2010.

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I. REAL PARTY IN INTEREST

The real party in interest of the present application, solely for purposes of identifying and avoiding potential conflicts of interest by board members due to working in matters in which the member has a financial interest is SONY ERICSSON MOBILE COMMUNICATIONS AB, which is an assignee of record of the present application.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals, interferences, or judicial proceedings.

III. STATUS OF CLAIMS

Claims 1-20 are pending in the present application, were finally rejected in the final Office Action, dated September 24, 2009, and are the subject of the present appeal. An After Final Request for Reconsideration was filed on November 24, 2009. An Advisory Action was mailed on January 13, 2010, upholding the rejections set forth in the final Office Action. Claims 1-20 are reproduced in the Claim Appendix of this Appeal Brief.

IV. STATUS OF AMENDMENTS

No claims have been amended after the final Office Action mailed September 24, 2009.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The following summary of the presently claimed subject matter indicates certain portions of the specification (including the drawings) that provide examples of embodiments of elements of the claimed subject matter. It is to be understood that other portions of the specification not cited herein may also provide examples of embodiments of elements of the claimed subject matter. It is also to be understood that the indicated examples are merely examples, and the scope of the claimed subject matter includes alternative embodiments and equivalents thereof. References herein to the specification are thus intended to be exemplary and not limiting.

Claim 1 recites a method of preparing a message in an electronic communication device (*see, e.g.*, p. 5, lines 25-26; *see also* Fig. 1 (10)), the method comprising providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types (*see, e.g.*, p. 7, lines 4-9; *see also* Fig. 2 (100)); detecting, via a control unit of the electronic communication device, a user selection of a particular message type of the plurality of message types (*see, e.g.*, p. 7, lines 24-26; *see also* Fig. 2 (108)); receiving the message in the editor (*see, e.g.*, p. 6, lines 12-13 and p. 7, line 31; *see also* Fig. 2 (110)); and changing, via the control unit, a transmission format for the message in dependence of the user selection (*see, e.g.*, p. 7, lines 26-29; *see also* original claim 1), where the message is received in advance of the changing the transmission format (*see, e.g.*, p. 2, lines 5-7).

Claim 2 recites the method according to claim 1, further comprising displaying the message on an information presentation unit in a format corresponding with the selected message type (*see, e.g.*, p. 7, lines 24-29; *see also* original claim 2).

Claim 4 recites the method according to claim 1, further comprising saving the message (*see, e.g.*, p. 7, lines 31-32; *see also* original claim 4).

Claim 5 recites the method according to claim 4, where the saving is performed in a general

format (*see, e.g.*, p. 7, lines 31-32; *see also* original claim 5).

Claim 6 recites a device for preparing a message in an electronic communication device (*see, e.g.*, p. 5, lines 25-26; *see also* Fig. 1 (10)), comprising a message type selection unit providing a set of message types that can be selected by a user (*see, e.g.*, p. 6, lines 22-27; *see also* Fig. 1 (19)), a first user input unit, for allowing message type selection by the user (*see, e.g.*, p. 6, lines 4-10; *see also* Fig. 1 (32)), and a control unit (*see, e.g.*, p. 6, line 34; *see also*, Fig. 1 (40)) arranged to provide the set of items of message types that can be selected by a user in an editor having a format common for all message types (*see, e.g.*, p. 7, lines 4-9; *see also* Fig. 2 (100)), detect a message selection by a user via said first user input unit (*see, e.g.*, p. 7, lines 24-26; *see also* Fig. 2 (108)), change a transmission format in dependence of the selections made by the user which provides preparing and saving a message in advance of deciding final message type for transmission or saving thereof (*see, e.g.*, p. 7, lines 26-29; *see also* original claim 1).

Claim 9 recites the device according to claim 6, further comprising a user selectable store to store a message, where the control unit is further to save a message in the store in a general format (*see, e.g.*, p. 7, lines 31-34; *see also* original claim 9).

Claim 10 recites the device according to claim 9, where the control unit is to automatically save the message in the store (*see, e.g.*, p. 7, lines 31-34; *see also* original claim 10).

Claim 14 recites the device according to claim 6, where tools not relevant to a selected message format are displayed on a display of the electronic communication device but are not user selectable so that a user can continue to edit in the selected message format only (*see, e.g.*, p. 7, lines 27-29).

Claim 17 recites the method according to claim 1, where the set of message types comprises at least one of a Short Message Service (SMS) message, an Enhanced Message Service (EMS)

message, a Multimedia Message Service (MMS) message, an electronic mail (e-mail) with attachment, an e-mail without attachment, or a blog message (*see, e.g.* p. 6, lines 22-27).

Claim 18 recites a method comprising, at a display of a communication device (*see, e.g.*, p. 5, lines 25-26; *see also* Fig. 1 (10)), displaying a message editor without requiring selection of a message type (*see, e.g.*, p. 2, lines 5-7); via a first input unit of the communication device, receiving a message at the message editor (*see, e.g.*, p. 6, lines 12-13); after receiving the message, displaying, at the display of the communication device, a plurality of selectable candidate message types for the message (*see, e.g.*, p. 6, lines 22-27 and p. 2, lines 5-7; *see also* Fig. 1 (19)); receiving, via a second input unit of the communication device, a selection of a particular message type (*see, e.g.*, p. 7, lines 24-26; *see also* Fig. 2 (108)); and assigning the selected particular message type to the received message (*see, e.g.*, p. 7, lines 26-29).

Claim 20 recites the method according to claim 18, further comprising transmitting the message from the communication device in a transmission format based on the selected particular message type (*see, e.g.*, p. 7, lines 26-27).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. As set forth in the final Office Action, claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

B. As set forth in the final Office Action, claims 1-20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over L'HEUREUX et al. (U.S. Patent No. 6,697,942) in view of ENGSTROM et al. (U.S. Patent No. 7,212,808).

VII. ARGUMENTS

A. The rejection of claims 1-20 under 35 U.S.C. § 112, second paragraph, as indefinite should be reversed.

With respect to the rejection of claims 1-20 under 35 U.S.C. § 112, second paragraph, the Examiner alleges that it is not clear what defines the term, "transmission format" (final Office Action, p. 2). Appellants initially note that independent claim 18 and claim 19 (which depends from claim 18) do not recite "transmission format." Therefore, this rejection does not apply to claims 18 and 19.

Moreover, Appellants submit that this term has sufficient meaning, both under the plain English definition of the term, as well as in the art. A "transmission format" of a message may be properly interpreted as, for example, a format of transmission of the message, or a format by which the message is transmitted. For instance, a transmission format for an e-mail message would be a format by which e-mails are transmitted, a transmission format for an SMS message would be a format by which SMS messages are transmitted, etc. Thus, Appellants submit that the term "transmission format" is clear.

The Examiner further states that, for the purposes of examination, the Examiner "assumes the claims refer to the fact that the message may be formatted differently based on the user selection" (*id.*). The Examiner is ignoring the actual language recited in the claim (*i.e.*, transmission format) and is, instead, applying the Examiner's own language (*i.e.*, message may be formatted). Furthermore, the Examiner does not explain how a message being formatted differently can be reasonably construed as corresponding to a transmission format. Thus, Appellants submit that the Examiner's interpretation is unreasonable, and that the Examiner has not established a *prima facie* case of indefiniteness.

In the Advisory Action, dated January 13, 2010, the Examiner alleges (Advisory Action, p.

2):

An email without an attachment is sent with a different transmission format than an email with an attachment. The examiner notes that the broadly claimed 'transmission format' can be read as any layer of signaling protocol.

Appellants submit that the Examiner has not explained how an email with an attachment could be reasonably construed as being sent in a different transmission format than an email with an attachment. Appellants further submit that the Examiner is concocting the Examiner's own language, which does not apply to the claims (*i.e.*, "any layer of signaling protocol"). As such, Appellants submit that the Examiner has not established a *prima facie* case of indefiniteness.

Moreover, in light of the remarks made by Appellants on pp. 4-5 of Appellants' After Final Request for Reconsideration, dated November 24, 2010 (*i.e.*, "For instance, a transmission format for an e-mail message would be a format by which e-mails are transmitted, a transmission format for an SMS message would be a format by which SMS messages are transmitted, etc."), Appellants submit that the Examiner's allegation is unreasonable. In light of the above remarks, an e-mail message with or without an attachment would be considered as being transmitted through the same transmission format.¹ Thus, Appellants submit that the Examiner's allegation is unreasonable.

Notwithstanding the above remarks, Appellants note that claims 1-16 and 18-20 do not recite an e-mail at all. Thus, without suggesting that the rejection of claim 17 is proper, this rejection does not apply to claims 1-16 and 18-20 at all.

Further with respect to claims 1-20, the Examiner alleges that it is not clear what defines a "message type" (final Office Action, p. 2). The Examiner states that "Applicant's claims recite that an email with a message is a different type than an email without a message" (*id.*). Appellants

¹ See also, *e.g.*, Appellants' Specification at p. 6, lines 22-27, which provide a list of example message types, including, *inter alia*, an "e-mail with or without attachment file." See also Appellants' Specification at p. 7, lines 26-27, which discloses "message type selection is detected, step 108, and transmission format is changed in dependence of selections made by the user. . . ."

initially note that claims 1-16 and 18-20 do not recite an e-mail at all. Thus, without suggesting that the rejection of claim 17 is proper, this rejection does not apply to claims 1-16 and 18-20 at all.

Furthermore, Appellants submit that nowhere do the claims recite that an email with a message is a different type than an email without a message, as alleged by the Examiner. Appellants assume the Examiner is referring to claim 17, which recites, *inter alia*, that the set of message types comprises at least one of an e-mail with attachment, or an e-mail without attachment. Appellants point out that nowhere in this claim, or any other claim, is it recited that an e-mail with an attachment and an e-mail without an attachment are two different types of messages.

The fact that an e-mail with an attachment and an e-mail without an attachment are each enumerated separately in this dependent claim does not imply that these are different message types. In fact, as set forth in Appellants' arguments with respect to the references, as well as in Appellants' Specification, an e-mail with an attachment and an e-mail without an attachment would be considered the same message type, *i.e.*, an e-mail (*see, e.g.*, Appellants' Specification, p. 6, lines 17-19 and 22-27). Thus, Appellants submit that the term "message type" is clear.

The Examiner further states that, for the purposes of examination, the Examiner "assumes any message with different data types could be considered a different type of message" (Office Action, p. 2.). Therefore, Appellants submit that, for at least the reasons provided above, the Examiner's interpretation is unreasonable.

Appellants further submit that the Examiner appears to improperly apply this interpretation of claim 17 to all claims, including those that do not recite these features. Therefore, this rejection is improper as applied to these other claims.

With respect to claims 18-20, the Examiner alleges that it is not clear what is meant by the phrase "a 'message editor' that receives a message" (final Office Action, p. 3). The Examiner further states, "[f]or the purposes of examination the examiner assumes the claim recites that the user

composes a message in a message editor" (*id.*). Without limiting the scope of these claims to the Examiner's interpretation, Appellants acknowledge that the Examiner's interpretation of this phrase is an example of a possible reasonable interpretation of this phrase. Thus, Appellants submit that the above phrase is sufficiently clear.

For at least the foregoing reasons, Appellants submit that the rejection of claims 1-20 under 35 U.S.C. § 112, second paragraph, is improper. Accordingly, Appellants request that the rejection be reversed.

B. The rejection of claims 1-20 under 35 U.S.C. § 103(a) as unpatentable over L'HEUREUX et al. and ENGSTROM et al. should be reversed.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention always rests upon the Examiner. In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner must provide a factual basis to support the conclusion of obviousness. In re Warner, 379 F.2d 1011, 154 U.S.P.Q. 173 (C.C.P.A. 1967). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by Graham v. John Deere Co., 86 S. Ct. 684, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). KSR International Co. v. Teleflex Inc., 550 U.S. 398, 82 U.S.P.Q.2d 1385 (2007). The Examiner is also required to explain how and why one having ordinary skill in the art would have been realistically motivated to modify an applied reference and/or combine applied references to arrive at the claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

1. Claims 1 and 3

Independent claim 1 recites a method of preparing a message in an electronic communication device, the method comprising providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a

plurality of message types; detecting, via a control unit of the electronic communication device, a user selection of a particular message type of the plurality of message types; receiving the message in the editor; and changing, via the control unit, a transmission format for the message in dependence of the user selection, where the message is received in advance of the changing the transmission format. L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, do not disclose or suggest one or more of these features.

For example, L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, do not disclose or suggest providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types, as recited in claim 1. The Examiner relies on col. 3, lines 1-30 of L'HEUREUX et al. as allegedly disclosing "a common editor for all the different types of messages" and on col. 5, lines 40-50 of L'HEUREUX et al. as allegedly disclosing "the user selects the message type" (final Office Action, p. 3). Appellants submit that neither this section nor any other section of L'HEUREUX et al. discloses or suggests the above feature of claim 1.

At col. 3, lines 1-31, L'HEUREUX et al. discloses:

SUMMARY OF THE INVENTION

The present invention describes a data formatting method for embedding diverse data types in an electronic mail message by forming a network compliant e-mail message header, generating one or more command blocks representing diverse data types, and combining the data types with the message header such that the e-mail message conforms to network standards. In operation, data are edited on and sent from a first system, for example, a subscriber service center, by means of a set of custom message commands. The editing system at the sender's location employs a Graphical User Interface (GUI) enabling non-sophisticated users to create complex mixed data type messages. The mixed data type message may contain commands to reset the configuration of a remote device, for example to change a password or update a device setting. Additionally, other segments, or blocks of the message may contain a graphic image and/or a plain text message. The exact nature of the data depends upon predefined data types.

At the sender's location the mixed data type message is passed from the graphical user interface to a command formatter which translates the GUI output into a custom command format suitable for the receiving apparatus to interpret. A standard e-mail header is then formed and the two parts of the message are combined into e-mail format for transmission. Once in the proper format, the e-mail message may be transferred over standard e-mail networks using standard e-mail protocols. For example, an e-mail message may be sent over the Internet to a SMTP server using SMTP/MIME protocols. From the SMTP server the message is transferred to the recipient's POP server where it is stored until the recipient downloads it during an e-mail session.

This section of L'HEUREUX et al. discloses embedding diverse data types into an electronic mail message. In other words, there is a single message type (*i.e.*, e-mail) into which different data types (*e.g.*, plain text, graphic image) can be incorporated. This section of L'HEUREUX et al. does not disclose a common editor for all message types, as recited in claim 1. Instead, this section of L'HEUREUX et al., at best, discloses an editor for a single message type (*i.e.*, e-mail).

Moreover, this section of L'HEUREUX et al. does not disclose a set of message types that can be selected by a user, as L'HEUREUX et al. discloses only a single message type (*i.e.*, e-mail), without providing any other message types that can be selected by a user. As such, Appellants submit that L'HEUREUX et al. does not disclose or suggest providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types, as recited in claim 1.

At col. 5, lines 40-54, L'HEUREUX et al. discloses:

The GUI software 210 provides a non-skilled user with the ability to construct a complex message containing multiple data types by checking boxes, selecting from pop-up menus, painting with conventional bitmap editing tools, and laying out forms with graphical tools, all methods well known to those skilled in the art. Although the GUI software of the present invention is not a requirement for constructing multiple data-type messages, one distinct advantage is its ease of use, accommodating those not skilled in software art. Thus, it is possible to construct a message by "hand" using a common text editor, for example a word processor, but it would be very difficult since the invention utilizes a dynamic security key which must be calculated and further, any graphical image to be embedded would have to be crafted bit by bit using the text editor.

This section of L'HEUREUX et al. discloses that a user can construct a "complex message" containing multiple data types. Nowhere does this section of L'HEUREUX et al. disclose or suggest a set of message types that can be selected by a user, let alone the above feature of claim 1. Instead, this section of L'HEUREUX et al. is directed to including multiple data types into an e-mail, which is a single message type (*see, e.g.*, L'HEUREUX et al., col. 1, lines 11-14 ("this invention relates to a technique for processing diverse data within standard electronic mail (e-mail) messages")). Since L'HEUREUX et al. does not disclose multiple message types, this section of L'HEUREUX et al. cannot be reasonably construed to disclose or suggest providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types, as recited in claim 1.

Moreover, Appellants submit that L'HEUREUX et al. teaches away from a set of message types that can be selected by a user in an editor common for all message types. L'HEUREUX et al. is directed to "embedding diverse types in an electronic mail message" (L'HEUREUX et al., Abstract) (emphasis added). The above sections of L'HEUREUX et al. elaborate on a method by which different data types are incorporated into a "standard" e-mail. For instance, a "standard e-mail header" is formed, and the "e-mail message [is] transferred over standard e-mail networks using standard e-mail protocols" (L'HEUREUX et al., col. 3, lines 26-29) (emphasis added).

Appellants submit that to construe L'HEUREUX et al. as disclosing a set of message types (that can be selected by a user in an editor common for all message types of a plurality of message types), or an editor common for all message types of a plurality of message types, would completely obviate the entirety of L'HEUREUX et al.'s teachings, which are directed to modifying and sending a standard e-mail. As such, Appellants submit that L'HEUREUX et al. teaches away from providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types, as recited in claim

1.

The Examiner further alleges that arguing that L'HEUREUX et al. discloses only a single message type is in direct contrast with Appellants' claim 17, which recites, *inter alia*, that the set of message types comprises at least one of an e-mail with attachment, or an e-mail without attachment. As discussed above, nowhere in this claim, or any other claim, is it recited that an e-mail with an attachment and an e-mail without an attachment are two different types of messages. In fact, as also discussed above, an e-mail with an attachment and an e-mail without an attachment would be considered the same message type; *i.e.*, an e-mail (*see, e.g.*, Appellants' Specification, p. 6, lines 17-19, 24-27). As such, Appellants submit that L'HEUREUX et al., which is directed solely to e-mail, cannot be reasonably relied upon as disclosing a plurality of message types, as recited in claim 1.

Appellants submit that the disclosure of ENGSTROM et al., which was not cited for disclosing or suggesting the above feature of claim 1, does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

Further with respect to claim 1, the Examiner alleges (final Office Action, p. 4):

The terminal inherently comprises input means and display means for the purpose of letting the user 'select' any known type of data to be transferred (selecting a message type, and detection of a user selection)

Appellants disagree with the Examiner's allegations. Terminal 110 in L'HEUREUX et al. corresponds to an editing terminal, such as a desktop computer (L'HEUREUX et al., col. 4, line 66-col. 5, line 2). L'HEUREUX et al. discloses that terminal 110 is used to compose e-mail messages that include the diverse data (L'HEUREUX et al., col. 4, line 66-col. 5, line 2). Clearly, L'HEUREUX et al. does not disclose or suggest (inherently or otherwise) input means and display means, as the Examiner alleges, for the purpose of letting a user select a message type.

Furthermore, as set forth in Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original):

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Here, the Examiner provides no basis in fact or technical reasoning to support the Examiner's assertion of inherency. Thus, Appellants submit that the Examiner has not met the requirements set forth by the Board of Patent Appeals and Interferences in Levy, and has therefore not met the burden required to establish a proper case of inherency.

Appellants submit that the disclosure of ENGSTROM et al. does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

Furthermore, with respect to claim 1, the Examiner alleges (final Office Action, p. 3):

L'Heurux discloses a messaging system (email) for a portable terminal that provides a common interface for different message types (abstract).

Appellants disagree with the Examiner's allegation that L'HEUREUX et al. discloses a common interface for different message types. As mentioned above, L'HEUREUX et al. is directed to only a single message type (i.e., e-mail), and does not disclose a common interface for different message types. Moreover, the Appellants submit that the Abstract of L'HEUREUX et al. in no way supports the Examiner's allegation.

Appellants submit that the disclosure of ENGSTROM et al., which was not cited for disclosing or suggesting the above feature of claim 1, does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

Further still with respect to claim 1, Appellants submit that the Examiner has not addressed all of the features of claim 1. For instance, Appellants submit that the Examiner has not alleged that any cited reference discloses or suggests changing, via the control unit, a transmission format for the message in dependence of the user selection, where the message is received in advance of the changing the transmission format, as recited in claim 1.

The Examiner alleges (final Office Action, p. 4):

Engstrom discloses a messaging service where the transmission protocol is automatically selected based on the chosen message type (Col 5 line 65).

Appellants point out that claim 1 does not recite a "transmission protocol," as alleged by the Examiner. This allegation does not address any of the actual claimed features recited in claim 1, nor does the Examiner explain how this allegation relates in any way to the actual claimed features recited in claim 1. The cited section of ENGSTROM et al. also has no apparent relevance to claim 1 (*see* ENGSTROM et al., col. 5, line 65 ("In one embodiment, support is also provided for a user to")). Therefore, the Appellants submit that Examiner fails to establish a *prima facie* case of obviousness with respect to claim 1.

Appellants further note that, at col. 5, line 65-col. 6, lines 11, ENGSTROM et al. discloses:

In one embodiment, support is also provided for a user to reply to any message in the unified stack/box by selecting a message and pressing a particular number on the cell phone key pay. For text messages, pressing the reply command may open a new text message addressed to the sender of the selected message. Similarly, selecting an email message and pressing the reply command may open a new email message addressed to the sender of the selected message. For a voice message, pressing reply may dial the callers phone number. In each case, the unified message function is equipped to be able to discern the appropriate communication protocol, e.g. by way of the message type. The same interface command applies for any message in the unified stack/box using any available message protocol.

This section of ENGSTROM et al. discloses that a user may select a message (*e.g.*, a text message) and press a reply command to open a new message of the same type (*e.g.*, a text message). Without acquiescing that opening this new message discloses or suggests changing a transmission format, Appellants submit that this section of ENGSTROM et al. does not disclose or suggest that a message is received in advance of changing a transmission format. Moreover, Appellants note that this section of ENGSTROM et al. does not disclose or suggest changing a transmission format for a message. Therefore, this section of ENGSTROM et al. does not disclose or suggest changing, via the control unit, a transmission format for the message in dependence of the user selection, where the

message is received in advance of the changing the transmission format, as recited in claim 1.

Furthermore, Appellants assert that the reasons for combining L'HEUREUX et al. and ENGSTROM et al. do not satisfy the requirements of 35 U.S.C. § 103. For example, with respect to the reasons for combining L'HEUREUX et al. and ENGSTROM et al., the Examiner alleges (final Office Action, p. 4):

It would have been obvious to implement the automatic protocol selection function for the advantage that the protocol will be automatically selected.

Appellants submit that the Examiner's allegation is merely a conclusory statement of an alleged benefit of the combination. Such conclusory statements have been repeatedly held to be insufficient for establishing a *prima facie* case of obviousness. In this respect, Appellants rely upon KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 82 U.S.P.Q.2d 1385, 1396 (2007) (citing In re Kahn, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006)), where it was held that rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

Furthermore, the Examiner does not explain how combining the disclosures L'HEUREUX et al. and ENGSTROM et al. would in fact provide the alleged benefit. The Examiner's allegations fall short of providing the articulated reasoning required by KSR. Thus, the Examiner has not established a *prima facie* case of obviousness with respect to claim 1.

For at least the foregoing reasons, Appellants submit that the rejection of claim 1 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

Claim 3 depends from claim 1. Therefore, Appellants request that the rejection of this claim be reversed for at least the reasons given above with respect to claim 1.

2. Claim 2

Claim 2 depends from claim 1. Therefore, Appellants request that the rejection of this claim be reversed for at least the reasons given above with respect to claim 1. Moreover, this claim recites additional features not disclosed or suggested by L'HEUREUX et al. and ENGSTROM et al.

For instance, L'HEUREUX et al. and ENGSTROM et al. do not disclose or suggest displaying the message on an information presentation unit in a format corresponding with the selected message type, as recited in claim 2. The Examiner alleges, "the received message content is displayed by the appropriate application on the terminals" (final Office Action, p. 4). Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 2.

Appellants initially note that the Examiner has not provided any evidentiary basis in this rejection. For instance, the Examiner has not cited to any of the references as allegedly disclosing this feature. Furthermore, without acquiescing that it would have been proper to do so, the Examiner has not relied on official notice in this rejection.

Appellants further note that the Examiner does not address the actual language recited in claim 2. Instead, the Examiner merely concocts language of the Examiner's choosing (*i.e.*, "the received message content is displayed by the appropriate application on the terminals") without explaining how this concocted language in any way relates to the claimed feature, let alone how this concocted language could be construed as rendering the claimed feature obvious. Accordingly, Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 2.

For at least the foregoing additional reasons, Appellants submit that the rejection of claim 2 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

3. Claim 4

Claim 4 depends from claim 1. Therefore, Appellants request that the rejection of this claim be reversed for at least the reasons given above with respect to claim 1. Moreover, this claim recites additional features not disclosed or suggested by L'HEUREUX et al. and ENGSTROM et al.

For instance, L'HEUREUX et al. and ENGSTROM et al. do not disclose or suggest saving the message, as recited in claim 4. The Examiner alleges, "all data must be saved (in a 'general format') at every processing stage in the terminal in order for the data to be processed. The saving is 'automatic' for those functions that do not require user input to procede [sic]" (final Office Action, p. 4). Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 4.

Appellants note that the Examiner has not provided any evidentiary basis in this rejection. For instance, the Examiner has not cited to any of the references as allegedly disclosing this feature. Furthermore, without acquiescing that it would have been proper to do so, the Examiner has not relied on official notice in this rejection. Accordingly, Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 4.

For at least the foregoing additional reasons, Appellants submit that the rejection of claim 4 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

4. Claim 5

Claim 5 depends from claim 4. Therefore, Appellants request that the rejection of this claim be reversed for at least the reasons given above with respect to claim 1. Moreover, this claim recites additional features not disclosed or suggested by L'HEUREUX et al. and ENGSTROM et al.

For instance, L'HEUREUX et al. and ENGSTROM et al. do not disclose or suggest that the saving is performed in a general format, as recited in claim 5. The Examiner alleges, "all data must

be saved (in a 'general format') at every processing stage in the terminal in order for the data to be processed. The saving is 'automatic' for those functions that do not require user input to proceed [sic]" (final Office Action, p. 4). Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 5.

Appellants note that the Examiner has not provided any evidentiary basis in this rejection. For instance, the Examiner has not cited to any of the references as allegedly disclosing this feature. Furthermore, without acquiescing that it would have been proper to do so, the Examiner has not relied on official notice in this rejection. Accordingly, Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 5.

For at least the foregoing additional reasons, Appellants submit that the rejection of claim 5 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

5. Claim 17

Claim 17 depends from claim 1. Therefore, Appellants request that the rejection of this claim be reversed for at least the reasons given above with respect to claim 1. Moreover, this claim recites additional features not disclosed or suggested by L'HEUREUX et al. and ENGSTROM et al.

For instance, L'HEUREUX et al. and ENGSTROM et al. do not disclose or suggest that the set of message types comprises at least one of a Short Message Service (SMS) message, an Enhanced Message Service (EMS) message, a Multimedia Message Service (MMS) message, an electronic mail (e-mail) with attachment, an e-mail without attachment, or a blog message, as recited in claim 17. The Examiner alleges, "the embedded data structure comprises an email protocol. The examiner further notes that it would have been obvious to use any well known communications protocol as that is the very reason for defining a protocol" (final Office Action, p. 5). Appellants

submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 17.

Appellants initially note that the Examiner has not provided any evidentiary basis in this rejection. For instance, the Examiner has not cited to any of the references as allegedly disclosing this feature. Furthermore, without acquiescing that it would have been proper to do so, the Examiner has not relied on official notice in this rejection. Accordingly, Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 17.

Appellants further note that the Examiner does not address the actual language recited in claim 17. Instead, the Examiner merely concocts language of the Examiner's choosing (*e.g.*, "the embedded data structure comprises an email protocol.") without explaining how this concocted language in any way relates to the claimed feature, let alone how this concocted language could be construed as rendering the claimed feature obvious. Accordingly, Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 17.

For at least the foregoing additional reasons, Appellants submit that the rejection of claim 17 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

6. Claims 6-8, 11-13, 15, and 16

Independent claim 6 recites a device for preparing a message in an electronic communication device, comprising a message type selection unit providing a set of message types that can be selected by a user, a first user input unit, for allowing message type selection by the user, and a control unit arranged to provide the set of items of message types that can be selected by a user in an editor having a format common for all message types, detect a message selection by a user via said first user input unit, change a transmission format in dependence of the selections made by the user which provides preparing and saving a message in advance of deciding final message type for

transmission or saving thereof. L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, do not disclose or suggest one or more of these features.

For example, L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, do not disclose or suggest a control unit arranged to provide a set of items of message types that can be selected by a user in an editor having a format common for all message types, as recited in claim 6. The Examiner relies on col. 3, lines 1-30 of L'HEUREUX et al. as allegedly disclosing "a common editor for all the different types of messages" and on col. 5, lines 40-50 of L'HEUREUX et al. as allegedly disclosing "the user selects the message type" (final Office Action, p. 3). Appellants submit that neither this section nor any other section of L'HEUREUX et al. discloses or suggests the above feature of claim 6.

At col. 3, lines 1-31 (reproduced above), L'HEUREUX et al. discloses embedding diverse data types into an electronic mail message. In other words, there is a single message type (*i.e.*, e-mail) into which different data types (*e.g.*, plain text, graphic image) can be incorporated. This section of L'HEUREUX et al. does not disclose an editor having a format common for all message types, as recited in claim 6. Instead, this section of L'HEUREUX et al., at best, discloses an editor for a single message type (*i.e.*, e-mail).

Moreover, this section of L'HEUREUX et al. does not disclose a set of message types that can be selected by a user, as L'HEUREUX et al. discloses only a single message type (*i.e.*, e-mail), without providing any other message types that can be selected by a user. As such, Appellants submit that L'HEUREUX et al. does not disclose or suggest a control unit arranged to provide a set of items of message types that can be selected by a user in an editor having a format common for all message types, as recited in claim 6.

At col. 5, lines 40-54 (reproduced above), L'HEUREUX et al. discloses that a user can construct a "complex message" containing multiple data types. Nowhere does this section of

L'HEUREUX et al. disclose or suggest a set of message types that can be selected by a user, let alone the above feature of claim 6. Instead, this section of L'HEUREUX et al. is directed to including multiple data types into an e-mail, which is a single message type (*see, e.g.*, L'HEUREUX et al., col. 1, lines 11-14 ("this invention relates to a technique for processing diverse data within standard electronic mail (e-mail) messages")). Since L'HEUREUX et al. does not disclose multiple message types, this section of L'HEUREUX et al. cannot be reasonably construed to disclose or suggest a control unit arranged to provide a set of items of message types that can be selected by a user in an editor having a format common for all message types, as recited in claim 6.

Moreover, Appellants submit that L'HEUREUX et al. teaches away from a set of message types that can be selected by a user in an editor common for all message types. L'HEUREUX et al. is directed to "embedding diverse types in an electronic mail message" (L'HEUREUX et al., Abstract) (emphasis added). The above sections of L'HEUREUX et al. elaborate on a method by which different data types are incorporated into a "standard" e-mail. For instance, a "standard e-mail header" is formed, and the "e-mail message [is] transferred over standard e-mail networks using standard e-mail protocols" (L'HEUREUX et al., col. 3, lines 26-29) (emphasis added).

Appellants submit that to construe L'HEUREUX et al. as disclosing a set of message types (that can be selected by a user in an editor common for all message types of a plurality of message types), or an editor having a format common for all message types, would completely obviate the entirety of L'HEUREUX et al.'s teachings, which are directed to modifying and sending a standard e-mail. As such, Appellants submit that L'HEUREUX et al. teaches away from a control unit arranged to provide a set of items of message types that can be selected by a user in an editor having a format common for all message types, as recited in claim 6.

The Examiner further alleges that arguing that L'HEUREUX et al. discloses only a single message type is in direct contrast with Appellants' claim 17, which recites, *inter alia*, that the set of

message types comprises at least one of an e-mail with attachment, or an e-mail without attachment. As discussed above, nowhere in this claim, or any other claim, is it recited that an e-mail with an attachment and an e-mail without an attachment are two different types of messages. In fact, as also discussed above, an e-mail with an attachment and an e-mail without an attachment would be considered the same message type, *i.e.*, an e-mail (*see, e.g.*, Appellants' Specification, p. 6, lines 17-19, 24-27). As such, Appellants submit that L'HEUREUX et al., which is directed solely to e-mail, cannot be reasonably relied upon as disclosing a set of message types, as recited in claim 6.

Appellants submit that the disclosure of ENGSTROM et al., which was not cited for disclosing or suggesting the above feature of claim 6, does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

Further with respect to claim 6, the Examiner alleges (final Office Action, p. 4):

The terminal inherently comprises input means and display means for the purpose of letting the user 'select' any known type of data to be transferred (selecting a message type, and detection of a user selection)

Appellants disagree with the Examiner's allegations. Terminal 110 in L'HEUREUX et al. corresponds to an editing terminal, such as a desktop computer (L'HEUREUX et al., col. 4, line 66-col. 5, line 2). L'HEUREUX et al. discloses that terminal 110 is used to compose e-mail messages that include the diverse data (L'HEUREUX et al., col. 4, line 66-col. 5, line 2). Clearly, L'HEUREUX et al. does not disclose or suggest (inherently or otherwise) input means and display means, as the Examiner alleges, for the purpose of letting a user select a message type.

The Examiner also provides no basis in fact or technical reasoning to support the Examiner's assertion of inherency. Thus, Appellants submit that the Examiner has not met the requirements set forth by the Board of Patent Appeals and Interferences in Levy, 17 U.S.P.Q.2d at 1464, and has therefore not met the burden required to establish a proper case of inherency.

Appellants submit that the disclosure of ENGSTROM et al. does not remedy the deficiencies

in the disclosure of L'HEUREUX et al. set forth above.

Furthermore, with respect to claim 6, the Examiner alleges (final Office Action, p. 3):

L'Heurux discloses a messaging system (email) for a portable terminal that provides a common interface for different message types (abstract).

Appellants disagree with the Examiner's allegation that L'HEUREUX et al. discloses a common interface for different message types. As mentioned above, L'HEUREUX et al. is directed to only a single message type (*i.e.*, e-mail), and does not disclose a common interface for different message types. Moreover, the Appellants submit that the Abstract of L'HEUREUX et al. in no way supports the Examiner's allegation.

Appellants submit that the disclosure of ENGSTROM et al., which was not cited for disclosing or suggesting the above feature of claim 6, does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

Further still with respect to claim 6, Appellants submit that the Examiner has not addressed all of the features of claim 6. For instance, Appellants submit that the Examiner has not alleged that any cited reference discloses or suggests a control unit arranged to change a transmission format in dependence of the selections made by the user which provides preparing and saving a message in advance of deciding final message type for transmission or saving thereof, as recited in claim 6.

The Examiner alleges (final Office Action, p. 4):

Engstrom discloses a messaging service where the transmission protocol is automatically selected based on the chosen message type (Col 5 line 65).

Appellants point out that claim 6 does not recite a "transmission protocol," as alleged by the Examiner. This allegation does not address any of the actual claimed features recited in claim 6, nor does the Examiner explain how this allegation relates in any way to the actual claimed features recited in claim 6. The cited section of ENGSTROM et al. also has no apparent relevance to claim 6

(see ENGSTROM et al., col. 5, line 65 ("In one embodiment, support is also provided for a user to"). Therefore, the Appellants submit that Examiner fails to establish a *prima facie* case of obviousness with respect to claim 6.

Appellants further note that, at col. 5, line 65-col. 6, lines 11 (reproduced above), ENGSTROM et al. discloses that a user may select a message (*e.g.*, a text message) and press a reply command to open a new message of the same type (*e.g.*, a text message). Without acquiescing that opening this new message discloses or suggests changing a transmission format, Appellants submit that this section of ENGSTROM et al. does not disclose or suggest saving a message in advance of deciding final message type for transmission or saving thereof. Therefore, this section of ENGSTROM et al. does not disclose or suggest changing, via the control unit, a transmission format for the message in dependence of the user selection, where the message is received in advance of the changing the transmission format, as recited in claim 6.

Furthermore, Appellants assert that the reasons for combining L'HEUREUX et al. and ENGSTROM et al. do not satisfy the requirements of 35 U.S.C. § 103. For example, with respect to the reasons for combining L'HEUREUX et al. and ENGSTROM et al., the Examiner alleges (final Office Action, p. 4):

It would have been obvious to implement the automatic protocol selection function for the advantage that the protocol will be automatically selected.

Appellants submit that the Examiner's allegation is merely a conclusory statement of an alleged benefit of the combination. Such conclusory statements have been repeatedly held to be insufficient for establishing a *prima facie* case of obviousness. In this respect, Appellants rely upon KSR, 550 U.S. at 398, 82 U.S.P.Q.2d at 1396 (citing In re Kahn, 441 F.3d at 988, 78 U.S.P.Q.2d at 1336), where it was held that rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to

support the legal conclusion of obviousness.

Furthermore, the Examiner does not explain how combining the disclosures L'HEUREUX et al. and ENGSTROM et al. would in fact provide the alleged benefit. The Examiner's allegations fall short of providing the articulated reasoning required by KSR. Thus, the Examiner has not established a *prima facie* case of obviousness with respect to claim 6.

For at least the foregoing reasons, Appellants submit that the rejection of claim 6 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

Claims 7, 8, 11-13, 15, and 16 depend from claim 6. Therefore, Appellants request that the rejection of these claims be reversed for at least the reasons given above with respect to claim 6.

7. Claim 9

Claim 9 depends from claim 6. Therefore, Appellants request that the rejection of this claim be reversed for at least the reasons given above with respect to claim 6. Moreover, this claim recites additional features not disclosed or suggested by L'HEUREUX et al. and ENGSTROM et al.

For instance, L'HEUREUX et al. and ENGSTROM et al. do not disclose or suggest a user selectable store to store a message, where the control unit is further to save a message in the store in a general format, as recited in claim 9. The Examiner alleges, "all data must be saved (in a 'general format') at every processing stage in the terminal in order for the data to be processed. The saving is 'automatic' for those functions that do not require user input to procede [sic]" (final Office Action, p. 4). Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 9.

Appellants note that the Examiner has not provided any evidentiary basis in this rejection. For instance, the Examiner has not cited to any of the references as allegedly disclosing this feature. Furthermore, without acquiescing that it would have been proper to do so, the Examiner has not

relied on official notice in this rejection. Accordingly, Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 9.

For at least the foregoing additional reasons, Appellants submit that the rejection of claim 9 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

8. Claim 10

Claim 10 depends from claim 9. Therefore, Appellants request that the rejection of this claim be reversed for at least the reasons given above with respect to claim 9. Moreover, this claim recites additional features not disclosed or suggested by L'HEUREUX et al. and ENGSTROM et al.

For instance, L'HEUREUX et al. and ENGSTROM et al. do not disclose or suggest that the control unit is to automatically save the message in the store, as recited in claim 10. The Examiner alleges, "all data must be saved (in a 'general format') at every processing stage in the terminal in order for the data to be processed. The saving is 'automatic' for those functions that do not require user input to procede [sic]" (final Office Action, p. 4). Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 10.

Appellants note that the Examiner has not provided any evidentiary basis in this rejection. For instance, the Examiner has not cited to any of the references as allegedly disclosing this feature. Furthermore, without acquiescing that it would have been proper to do so, the Examiner has not relied on official notice in this rejection. Accordingly, Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 10.

For at least the foregoing additional reasons, Appellants submit that the rejection of claim 10 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

9. Claim 14

Claim 14 depends from claim 6. Therefore, Appellants request that the rejection of this claim be reversed for at least the reasons given above with respect to claim 14. Moreover, this claim recites additional features not disclosed or suggested by L'HEUREUX et al. and ENGSTROM et al.

For instance, L'HEUREUX et al. and ENGSTROM et al. do not disclose or suggest that tools not relevant to a selected message format are displayed on a display of the electronic communication device but are not user selectable so that a user can continue to edit in the selected message format only, as recited in claim 14. The Examiner alleges, "the device is a portable terminal with a display in which the user navigates a series of menus. The gui [sic] interface will change and the options selectable by the user will change depending on the particular situation (such as being in the editor) that the user is in" (final Office Action, p. 4). Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 14.

Appellants initially note that the Examiner has not provided any evidentiary basis in this rejection. For instance, the Examiner has not cited to any of the references as allegedly disclosing this feature. Furthermore, without acquiescing that it would have been proper to do so, the Examiner has not relied on official notice in this rejection.

Furthermore, the Examiner does not address the actual features recited in claim 14. For instance, the Examiner does not in any way address that tools not relevant to a selected message format are displayed on a display of the electronic communication device but are not user selectable so that a user can continue to edit in the selected message format only, as recited in claim 14, nor does the Examiner explain how the Examiner's allegation is even remotely related to the above feature of claim 14. Accordingly, Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 14.

For at least the foregoing additional reasons, Appellants submit that the rejection of claim 14

under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

10. Claims 18 and 19

Independent claim 18 recites a method comprising, at a display of a communication device, displaying a message editor without requiring selection of a message type; via a first input unit of the communication device, receiving a message at the message editor; after receiving the message, displaying, at the display of the communication device, a plurality of selectable candidate message types for the message; receiving, via a second input unit of the communication device, a selection of a particular message type; and assigning the selected particular message type to the received message. L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, do not disclose or suggest one or more of these features.

For example, L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, do not disclose or suggest, after receiving a message, displaying, at a display of a communication device, a plurality of selectable candidate message types for the message, as recited in claim 18. The Examiner relies on col. 3, lines 1-30 of L'HEUREUX et al. as allegedly disclosing "a common editor for all the different types of messages" and on col. 5, lines 40-50 of L'HEUREUX et al. as allegedly disclosing "the user selects the message type" (final Office Action, p. 3). Appellants submit that neither this section nor any other section of L'HEUREUX et al. discloses or suggests the above feature of claim 18.

At col. 3, lines 1-31 (reproduced above), L'HEUREUX et al. discloses embedding diverse data types into an electronic mail message. In other words, there is a single message type (*i.e.*, e-mail) into which different data types (*e.g.*, plain text, graphic image) can be incorporated. This section of L'HEUREUX et al. does not disclose a plurality of selectable candidate types for a message, as recited in claim 18. Instead, this section of L'HEUREUX et al., at best, discloses an

editor for a single message type (*i.e.*, e-mail). Thus, this section of L'HEUREUX et al. does not disclose or suggest the above feature of claim 18.

At col. 5, lines 40-54 (reproduced above), L'HEUREUX et al. discloses that a user can construct a "complex message" containing multiple data types. Nowhere does this section of L'HEUREUX et al. disclose or suggest a plurality of selectable candidate types for a message, let alone the above feature of claim 18. Instead, this section of L'HEUREUX et al. is directed to including multiple data types into an e-mail, which is a single message type (*see, e.g.*, L'HEUREUX et al., col. 1, lines 11-14 ("this invention relates to a technique for processing diverse data within standard electronic mail (e-mail) messages")). Since L'HEUREUX et al. does not disclose multiple message types, this section of L'HEUREUX et al. cannot be reasonably construed to disclose or suggest, after receiving a message, displaying, at a display of a communication device, a plurality of selectable candidate message types for the message, as recited in claim 18.

Moreover, Appellants submit that L'HEUREUX et al. teaches away from a plurality of selectable candidate message types. L'HEUREUX et al. is directed to "embedding diverse types in an electronic mail message" (L'HEUREUX et al., Abstract) (emphasis added). The above sections of L'HEUREUX et al. elaborate on a method by which different data types are incorporated into a "standard" e-mail. For instance, a "standard e-mail header" is formed, and the "e-mail message [is] transferred over standard e-mail networks using standard e-mail protocols" (L'HEUREUX et al., col. 3, lines 26-29) (emphasis added).

Appellants submit that to construe L'HEUREUX et al. as disclosing a plurality of selectable message types would completely obviate the entirety of L'HEUREUX et al.'s teachings, which are directed to modifying and sending a standard e-mail. As such, Appellants submit that L'HEUREUX et al. teaches away from displaying, after receiving a message, at a display of a communication device, a plurality of selectable candidate message types for the message, as recited in claim 18.

The Examiner further alleges that arguing that L'HEUREUX et al. discloses only a single message type is in direct contrast with Appellants' claim 17, which recites, *inter alia*, that the set of message types comprises at least one of an e-mail with attachment, or an e-mail without attachment. As discussed above, nowhere in this claim, or any other claim, is it recited that an e-mail with an attachment and an e-mail without an attachment are two different types of messages. In fact, as also discussed above, an e-mail with an attachment and an e-mail without an attachment would be considered the same message type, *i.e.*, an e-mail (*see, e.g.*, Appellants' Specification, p. 6, lines 17-19, 24-27). As such, Appellants submit that L'HEUREUX et al., which is directed solely to e-mail, cannot be reasonably relied upon as disclosing a plurality of message types, as recited in claim 18.

Appellants submit that the disclosure of ENGSTROM et al., which was not cited for disclosing or suggesting the above feature of claim 18, does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

Further with respect to claim 18, the Examiner alleges (final Office Action, p. 4):

The terminal inherently comprises input means and display means for the purpose of letting the user 'select' any known type of data to be transferred (selecting a message type, and detection of a user selection)

Appellants disagree with the Examiner's allegations. Terminal 110 in L'HEUREUX et al. corresponds to an editing terminal, such as a desktop computer (L'HEUREUX et al., col. 4, line 66-col. 5, line 2). L'HEUREUX et al. discloses that terminal 110 is used to compose e-mail messages that include the diverse data (L'HEUREUX et al., col. 4, line 66-col. 5, line 2). Clearly, L'HEUREUX et al. does not disclose or suggest (inherently or otherwise) input means and display means, as the Examiner alleges, for the purpose of letting a user select a message type.

The Examiner also provides no basis in fact or technical reasoning to support the Examiner's assertion of inherency. Thus, Appellants submit that the Examiner has not met the requirements set forth by the Board of Patent Appeals and Interferences in Levy, 17 U.S.P.Q.2d at 1464, and has

therefore not met the burden required to establish a proper case of inherency.

Appellants submit that the disclosure of ENGSTROM et al. does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

Furthermore, with respect to claim 18, the Examiner alleges (final Office Action, p. 3):

L'Heurux discloses a messaging system (email) for a portable terminal that provides a common interface for different message types (abstract).

Appellants disagree with the Examiner's allegation that L'HEUREUX et al. discloses a common interface for different message types. As mentioned above, L'HEUREUX et al. is directed to only a single message type (*i.e.*, e-mail), and does not disclose a common interface for different message types. Moreover, the Appellants submit that the Abstract of L'HEUREUX et al. in no way supports the Examiner's allegation.

Appellants submit that the disclosure of ENGSTROM et al., which was not cited for disclosing or suggesting the above feature of claim 18, does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

Further still with respect to claim 18, Appellants submit that the Examiner has not addressed all of the features of claim 18. For instance, Appellants submit that the Examiner has not alleged that any cited reference discloses or suggests, after receiving a message, displaying, at a display of a communication device, a plurality of selectable candidate message types for the message, as recited in claim 18.

The Examiner alleges (final Office Action, p. 4):

Engstrom discloses a messaging service where the transmission protocol is automatically selected based on the chosen message type (Col 5 line 65).

Appellants point out that claim 18 does not recite a "transmission protocol," as alleged by the Examiner. This allegation does not address any of the actual claimed features recited in claim 18,

nor does the Examiner explain how this allegation relates in any way to the actual claimed features recited in claim 18. The cited section of ENGSTROM et al. also has no apparent relevance to claim 18 (*see* ENGSTROM et al., col. 5, line 65 ("In one embodiment, support is also provided for a user to"). Therefore, the Appellants submit that Examiner fails to establish a *prima facie* case of obviousness with respect to claim 18.

Appellants further note that, at col. 5, line 65-col. 6, lines 11 (reproduced above), ENGSTROM et al. discloses that a user may select a message (*e.g.*, a text message) and press a reply command to open a new message of the same type (*e.g.*, a text message). Without acquiescing that opening this new message discloses or suggests changing a transmission format, Appellants submit that this section of ENGSTROM et al. does not disclose or suggest, after receiving a message, displaying, at a display of a communication device, a plurality of selectable candidate message types for the message, as recited in claim 18.

Furthermore, Appellants assert that the reasons for combining L'HEUREUX et al. and ENGSTROM et al. do not satisfy the requirements of 35 U.S.C. § 103. For example, with respect to the reasons for combining L'HEUREUX et al. and ENGSTROM et al., the Examiner alleges (final Office Action, p. 4):

It would have been obvious to implement the automatic protocol selection function for the advantage that the protocol will be automatically selected.

Appellants submit that the Examiner's allegation is merely a conclusory statement of an alleged benefit of the combination. Such conclusory statements have been repeatedly held to be insufficient for establishing a *prima facie* case of obviousness. In this respect, Appellants rely upon KSR, 550 U.S. at 398, 82 U.S.P.Q.2d at 1396 (citing In re Kahn, 441 F.3d at 988, 78 U.S.P.Q.2d at 1336), where it was held that rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to

support the legal conclusion of obviousness.

Furthermore, the Examiner does not explain how combining the disclosures L'HEUREUX et al. and ENGSTROM et al. would in fact provide the alleged benefit. The Examiner's allegations fall short of providing the articulated reasoning required by KSR. Thus, the Examiner has not established a *prima facie* case of obviousness with respect to claim 18.

For at least the foregoing reasons, Appellants submit that the rejection of claim 18 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

Claim 19 depends from claim 18. Therefore, Appellants request that the rejection of this claim be reversed for at least the reasons given above with respect to claim 19.

11. Claim 20

Claim 20 depends from claim 18. Therefore, Appellants request that the rejection of this claim be reversed for at least the reasons given above with respect to claim 18. Moreover, this claim recites additional features not disclosed or suggested by L'HEUREUX et al. and ENGSTROM et al. For instance, L'HEUREUX et al. and ENGSTROM et al. do not disclose or suggest transmitting the message from the communication device in a transmission format based on the selected particular message type, as recited in claim 20. The Examiner alleges, "the type of message selected will be transmitted. The various text and data portions will comprise a different transmission protocol (a text payload and a picture payload for example)" (final Office Action, p. 5). Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 20.

Appellants initially note that the Examiner has not provided any evidentiary basis in this rejection. For instance, the Examiner has not cited to any of the references as allegedly disclosing this feature. Furthermore, without acquiescing that it would have been proper to do so, the Examiner has not relied on official notice in this rejection.

Furthermore, the Examiner does not address the actual features recited in claim 20. For instance, the Examiner does not in any way address transmitting the message from the communication device in a transmission format based on the selected particular message type, as recited in claim 20, nor does the Examiner explain how the Examiner's allegation is even remotely related to the above feature of claim 20. Accordingly, Appellants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 20.

For at least the foregoing additional reasons, Appellants submit that the rejection of claim 20 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

VIII. CONCLUSION

In view of the foregoing arguments, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections of claims 1-20.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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IX. CLAIM APPENDIX

1. A method of preparing a message in an electronic communication device, the method comprising:

providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types;

detecting, via a control unit of the electronic communication device, a user selection of a particular message type of the plurality of message types;

receiving the message in the editor; and

changing, via the control unit, a transmission format for the message in dependence of the user selection, where the message is received in advance of the changing the transmission format.

2. The method according to claim 1, further comprising displaying the message on an information presentation unit in a format corresponding with the selected message type.

3. The method according to claim 1, where a first user input unit allows actuation for and scrolling in a first direction and a second opposite direction, where detection of a selection by an actuation and confirmation of the first user input unit for one direction provides selection of a message type and the detection of the selection provides changing the transmission format.

4. The method according to claim 1, further comprising saving the message.

5. The method according to claim 4, where the saving is performed in a general format.

6. Device for preparing a message in an electronic communication device comprising:
a message type selection unit providing a set of message types that can be selected by
a user,
a first user input unit, for allowing message type selection by the user, and
a control unit arranged to:
provide the set of items of message types that can be selected by a user in an
editor having a format common for all message types,
detect a message selection by a user via said first user input unit,
change a transmission format in dependence of the selections made by the
user which provides preparing and saving a message in advance of deciding final message type for
transmission or saving thereof.
7. Device according to claim 6, where the first user input unit allows actuation for and
scrolling in a first direction and a second opposite direction, and a second user input unit is to
confirm a selection, where the detection of a selection by an actuation of the first user input unit for
one direction to an item and confirmation by the second user input unit provides selection of a
message type and the detection of a selection provides changing the transmission format in
dependence of the selections made by the user.
8. Device according to claim 6, where the control unit is to change the appearance on
an information presentation unit in dependence of the selections made by the user.

9. Device according to claim 6, further comprising a user selectable store to store a message, where the control unit is further to save a message in the store in a general format.

10. Device according to claim 9, where the control unit is to automatically save the message in the store.

11. Device according to claim 6, where the control unit is to upload the message to a predefined web address.

12. Device according to claim 6, where the control unit is to upload the message to a web address using an automated log-in.

13. Device according to claim 6, where the control unit is to upload the message to a web address without using an automated log-in.

14. Device according to claim 6, where tools not relevant to a selected message format are displayed on a display of the electronic communication device but are not user selectable so that a user can continue to edit in the selected message format only.

15. Device according to claim 6, where the device is a portable electronic communication device.

16. Device according to claim 15, where the device includes at least one of a cellular phone, a PDA, or a smart-phone.

17. The method according to claim 1, where the set of message types comprises at least one of a Short Message Service (SMS) message, an Enhanced Message Service (EMS) message, a Multimedia Message Service (MMS) message, an electronic mail (e-mail) with attachment, an e-mail without attachment, or a blog message.

18. A method comprising:
at a display of a communication device, displaying a message editor without requiring selection of a message type;
via a first input unit of the communication device, receiving a message at the message editor;
after receiving the message, displaying, at the display of the communication device, a plurality of selectable candidate message types for the message;
receiving, via a second input unit of the communication device, a selection of a particular message type; and
assigning the selected particular message type to the received message.

19. The method according to claim 18, where the plurality of selectable candidate message types are displayed in a scrollable menu.

20. The method according to claim 18, further comprising transmitting the message from the communication device in a transmission format based on the selected particular message type.

X. EVIDENCE APPENDIX
None

XI. RELATED PROCEEDINGS APPENDIX

None